

Application No. 10/731,409

Filed: December 9, 2003

TC Art Unit: 3677

Confirmation No.: 3924

FORMAL MATTERS

An Information Disclosure Statement was filed with the USPTO on November 28, 2005. The Applicants respectfully request that the Examiner consider the references cited therein before issuing her next Office Action and, moreover, that the Examiner provide the Applicants with a copy of the Form PTO 1449 that has been duly initialed to indicate such consideration.

REMARKS

Claims 1 and 2 are pending within the application. Applicants have amended claims 1 and 2 above. The amendments have support in the specification such that new matter has not been presented herein.

The above amendments to the claims should not be construed as acquiescence to the rejections by the Examiner and were provided solely to expedite the prosecution of the application. Applicants reserve the right to pursue the claims as originally filed in the present or a separate application(s).

Applicants respectfully request reconsideration and withdrawal of the rejections by the Examiner in view of the remarks presented herein.

Request for Withdrawal of Premature Final Rejection

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication Number 2003/0230829 to Shiraishi, et al. ("Shiraishi"). The Applicants believe that the finality of the Office Action is

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inappropriate. The claims were previously amended in response to rejections based on U.S. Patent Application Publication Number 2003/0224085 to Onuma, et al., which have since been withdrawn. This is the first instance that the Shiraishi reference has been cited against the invention as claimed.

The MPEP provides that:

A second or subsequent action on the merits in any application or patent undergoing reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claims amended to include limitations which should reasonably have been expected to be claimed.

MPEP, §706.07(a) (Emphasis added).

As provided above, the present rejections made final are based on the Shiraishi reference, which is newly cited in the Final Office Action. Claims 1 and 2 were previously amended in response to the Examiner's initial Office Action. For the following reasons, the limitations added to the original claims "should reasonably have been expected to be claimed," making the finality of the rejection premature.

In our response to the first Office Action, the original claim 1 term "splines provided on the screw shaft and the motor shaft" was amended to read -- a screw shaft spline and a motor shaft spline -- which is merely a re-wording of the original term and, therefore, should reasonably have been expected.

The original claim 1 term "the spline for the motor shaft engaging with the spline on an outer periphery on a shaft end portion of the screw shaft" was amended to read -- the screw shaft spline is formed on an outer periphery on a shaft end portion of

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the screw shaft -- which also is merely a re-wording of the original term, and therefore, should reasonably have been expected.

The original claim 1 term "the spline of the motor shaft . . . is provided on an inner periphery of a bearing sleeve" was amended to read -- an inner spline disposed at an inner periphery of the bearing sleeve -- which likewise is merely a re-wording of the original term, and therefore, should reasonably have been expected.

The original claim 1 term "fastening a flange integrally formed on an outer periphery of the bearing sleeve to an end face of the motor shaft with a bolt" was amended to read -- a flange integrally formed on an outer periphery of the bearing sleeve . . . and fastening the flange on an end face of the motor shaft with a bolt -- which similarly is merely a re-wording of the original term, and therefore, should reasonably have been expected.

The original claim 1 term "a bearing sleeve which is detachably mounted to the motor shaft by fitting the bearing sleeve into a recess formed inside a motor shaft end" was amended to read -- a rear portion disposed at the rear of the flange that is formed into a size fitted to a recess formed inside of an end of the motor shaft . . . wherein the bearing sleeve is detachably mounted to the motor shaft by fitting the rear portion of said bearing sleeve into the recess --.

This, too, is a general re-wording of the original term. The original claim term was amended to recite that it is the "rear portion" of the bearing sleeve that is fitted into the recess, which should reasonable have been expected, especially when the amendment removes an anticipation rejection.

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Accordingly, withdrawal of the finality of the present Office Action is respectfully requested.

Claim Rejections 35 U.S.C. § 102(e)

Notwithstanding the inappropriateness of the final rejection, claims 1 and 2 have been amended and the grounds for rejection are believed to be moot. Applicants further submit that the pending claims as amended are not anticipated or made obvious by the Shiraishi reference and any rejections by the Examiner under 35 U.S.C. § 102(e) should be withdrawn.

Specifically, according to the Examiner, the Shiraishi reference discloses a "coupling structure between screw shaft (4) . . . The bearing sleeve has an annular groove at the inner periphery of an opening for the side of the screw and a ring member (3) (Figs. 1-4)." However, claim 1 is currently amended to recite "an injection device, wherein a rotating movement of a screw shaft for driving an injection screw driving body caused by an electric motor is converted into a linear movement of an injection screw driving body by screwing the screw shaft and a nut member positioned at the injection screw driving body with each other and resin is injected according to an advancing movement of the injection screw driving body . . . " Shiraishi does not teach, mention or suggest such a feature. Accordingly, rejection under 35 U.S.C. § 102(e) should be withdrawn.

Furthermore, Shiraishi does not teach, mention or suggest a motor shaft spline engaging with a screw shaft spline to perform the rotating movement and resin injection as recited in claim 1.

Finally, with respect to Shiraishi's "screw shaft and ring member (3)", the reference number refers to a retainer. However,

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the retainer does not "air-tightly seal[] a clearance formed between the screw shaft and the bearing sleeve" as recited by claim 2. Accordingly, rejection under 35 U.S.C. § 102(e) should be withdrawn.

CONCLUSION

Based on the remarks presented herein, reconsideration and withdrawal of the finality of the Office Action and of the rejections by the Examiner and allowance of the application with the pending claims are respectfully requested.

The Examiner is also encouraged to telephone the undersigned attorney so as to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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